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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/921,465	08/03/2001	David M. Czech	11694/04101	7030

27483 7590 09/09/2005

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EXAMINER

KOCH, GEORGE R

ART UNIT PAPER NUMBER

1734

DATE MAILED: 09/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/921,465

Applicant(s)

CZECH ET AL.

Examiner

George R. Koch III

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 12-17 and 21-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 12-17 and 21-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(f) he did not himself invent the subject matter sought to be patented.

2. Claims 1-5, 12-17, and 21-27 are rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter. In application 09/921,462 (see US Publication 2002/0082753) an identical application with original claims that are identical to the original claims of this application was filed. The instant application has no inventors in common with application 09/921,462.

3. Claims 1-5, 12-17, and 21-27 are rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter. In application 09/921,480 (see US Publication 2002/0047051) an identical application with original claims that are identical to the original claims of this application was filed. The instant application has no inventors in common with application 09/921,480.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686

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F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-5, 12-17, and 21-27 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1-4, 12-22 of copending Application No. 09/921,480. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are obvious variants of each other.

Specifically, with regard to claim 1, the '480 application in claim 1 recites the user input device, the configuration program (called a configurator module) and the verifying component of the configuration component. The differences appear to be in the intended usage, and the structures of each system are considered capable of performing the others functions.

Claims 2-4 of the instant application matched with claims 2-4 of the '480 application.

Claims 12-13 of the instant application matched with claims 12-13 of the '480 application.

Claims 14 and 15 read on claims 19 and 20 fo the '480 application.

With regard to claim 16 and 23, the '480 application in claim 21 recites the user input device, the configuration program (called a configurator module) and

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the verifying component of the configuration component. The differences appear to be in the intended usage and terminology (for example, the instant claim uses "component list" and the '480 application uses "menu of material application component selection options", which are identical or obvious variants of each other), and the structures of each system are considered capable of performing the others functions. The case studies referred to in the final 5 lines of the instant application are considered identical or obvious variants to database of current and *historical information* referred to in the final 6 lines of the '480 application.

Claims 17 and 24 of the instant application matched with claim 22 of the '480 application.

The limitations of claim 5 are well known and conventional for material application systems. Liquid spray systems frequently include a gun, nozzle, and pump.

The limitations of claim 21-22 and 25-27 are well known and conventional for material application systems.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 1, 3, 21, 22 and 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jahn et al (US Patent 6,073,055) in view of the admitted prior art (pages 1 and 2 of the specification).

Jahn discloses a system for configuring a spaying application system, comprising user input device (for example, Figure 2, items 160) remotely located from a manufacturing site (for example, paint laboratories 132 and paint manufacturing laboratories 136), a configuration program accessible by the user input device over a communications network (item 169, called a network such as an Intranet or Extranet - see column 4, lines 24-40). Jahn is capable of allowing a user to access the specific configuration programs and having the configuration program verify component compatibility (see Figure 9, which discloses quality forward and quality backward modes).

Specifically, Jahn discloses that the configuration program presents component selection based on input data from the user input device, and the configuration program verifying component capability (see, especially Figures 6a and 6b, item 342, which shows values and options - See also column 6, line 60 to column 7, lines 15). Jahn recites various equipment types, i.e., components or gun types, the plural implying at least 2, as being stored in the database (column 7, lines 20-34). Jahn also discloses that the system has different components including application device such as a gun, in the specific form of bell atomizers

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(see column 6, line 60 to column 7, line 2). Jahn also discloses that the component selection options include application device design such as bell speed and bell fluids (column 6, line 60 to column 7, line 2).

Jahn discloses a equipment list (column 6, lines 60 to column 7, line 2) and the capability to enter the equipment, accessories, and configuration of the equipment, or gun, but does not further disclose that the component list includes details as to the guns and the pumps. Jahn is capable of being used for ordering for purchase from a manufacturers site.

The admitted prior art discloses that the parameters that are often included and monitor in a spray system include one or more (thus disclosing multiples) guns and pumps, material feed centers and recovery system (page 1, lines 29-39 - applicant's numbering). The admitted prior art also discloses that it is known to configure these components (page 2, lines 5-26 - applicant's numbering). That admitted prior art discloses that one would appreciate that such configurations would enable optimal coating parameters for the user. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized configuration or equipments lists including details as to the gun and pumps in order to configure for optimal coating parameters.

As to claim 3, Jahn discloses a pricing and inventory database (see Figure 7b, which discloses \$ per car, \$ per Kg/gal, and other price measures, and Figure 7a, which discloses in item 372, material data, material information and consumption, and in item 368, equipment list, accessories - see column 8).

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As to claim 21, Jahn discloses a visual representation of the system selection. (see Figure 4, 6A and 6B, for example).

As to claim 22, Jahn discloses a link to a bill of materials database (see Figures 4, Figure 7B, item 376 and especially Figure 8, which shows "Economy" with cost per KG/Gal... i.e., a bill of materials).

As to claim 26, Jahn's configuration lists includes several controls routines (for example, Figure 7A & 7B, item 353, or Figures 8, 9, 10A, and 10B, i.e., selection of control programs or systems.

As to claim 27, the system of Jahn is capable of being used in the intended manner.

3. Claims 1-4, 12, 14, 15, 21-22 and 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Friel et al (US Patent Publication 2003/0110101 A1) and further in view of Jahn (US 6,073,055) and the admitted prior art (pages 1 and 2 of the specification).

As to claim 1, Friel discloses a system for configuring an automotive assembly line including a spraying application system (see, for example, Figure 1, and paragraphs 0019, 0020, etc), a user input device located remotely from the manufacturing location (see, for example, items 131-133, and see especially paragraphs 0022, 0032 and 0033), a configuration program accessible by the user input device over a communication network, the configuration program presenting component selection options based on input data from the user input device, the configuration program verifying component compatibility (see

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paragraphs 0028-0033). This configuration program is capable of presenting the claimed configurations lists. Friel also discloses that the system has different components including application device such as a gun and valves, in the specific form of bell atomizers (see column 6, line 60 to column 7, line 2). Friel further discloses that the component selection options in control over which valves are activated (see paragraph 0020).

Friel is silent as to application device structure such as gun components and the selection of gun options or application device design in the gun structure.

Jahn also discloses that the system has different components including application device such as a gun, in the specific form of bell atomizers (see column 6, line 60 to column 7, line 2). Jahn also discloses that the component selection options include application device design such as bell speed and bell fluids (column 6, line 60 to column 7, line 2). In this passage, Jahn discloses that using a gun and having the capability to select component settings allows for generation of mathematical models through experiments, i.e., the capability to configure the material application system by entering the components. Jahn is capable of being used for ordering for purchase from a manufacturers site. One in the art would immediately appreciate that such capability allows for the identification of superior coating techniques for a specific setting. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized the different components of Jahn and application device design of Jahn in order to identify superior coating techniques, i.e., mathematical models, for different settings.

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Jahn discloses a equipment list (column 6, lines 60 to column 7, line 2) and the capability to enter the equipment, accessories, and configuration of the equipment, or gun, but does not further disclose that the component list includes details as to the guns and the pumps.

The admitted prior art discloses that the parameters that are often included and monitor in a spray system include one or more (thus disclosing pluralities of) guns and pumps, material feed centers and recovery system (page 1, lines 29-39 - applicant's numbering). The admitted prior art also discloses that it is known to configure these components (page 2, lines 5-26 - applicant's numbering). That admitted prior art discloses that one would appreciate that such configurations would enable optimal coating parameters for the user. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized configuration or equipments lists including details as to the gun and pumps in order to configure for optimal coating parameters.

As to claim 2, Friel discloses an Internet connection (see paragraph 0029).

As to claim 3, Friel discloses accessing a pricing and inventory database (see Figures 3a, 3b, 3c, and 3d, see also paragraphs 0024 to 0027).

As to claim 4, Friel discloses using secure web sites via known commercial solutions such as Internet Explorer™ and Netscape Navigator™ which are capable of presenting secure connections (paragraph 0022).

As to claim 12, Friel discloses using a server connected to the communication network (see Figure 1, items 130, 140, and 131-133. Item 130 is the communication network and item 140 is the server).

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As to claim 14, Friel discloses a drag and drop interface to permit a user to configure a system (see screen shot on Figure 2, see also paragraph 0023)

As to claim 15, Friel's screen shot is considered a wizard option to generate a configured system based on response inputs from the user to a number of questions. The configured system is the overall price (see item 250, Figure 2). Furthermore, Friel discloses more sophisticated wizard systems (see paragraph 0024).

As to claim 21, Friel discloses a visual representation of the system selection. (see Figure 2, for example). Furthermore, Jahn discloses a visual representation of the system selection. (see Figure 4, 6A and 6B, for example).

As to claim 22, Friel discloses a link to a bill of materials database (see Figures 3a and 3b, which discloses the cost of the materials). Furthermore, Jahn discloses a link to a bill of materials database (see Figures 4, Figure 7B, item 376 and especially Figure 8, which shows "Economy" with cost per KG/Gal... i.e., a bill of materials).

As to claim 26, Jahn's configuration lists as incorporated includes several controls routines (for example, Figure 7A & 7B, item 353, or Figures 8, 9, 10A, and 10B, i.e., selection of control programs or systems).

As to claim 27, the system of Jahn is capable of being used in the intended manner.

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4. Claims 2, 4, 13, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jahn and the admitted prior art as applied to claims 1 and 3 above, and further in view of Corrigan (US Patent 6,522,977).

As to claims 2, Jahn discloses that the input device comprises a personal computer, but is silent as to the use of the Internet.

Corrigan discloses a paint matching and spraying system in which desired color values are transmitted via the internet (see column 6, lines 12-22). The internet is well known for providing an affordable communications solution and dispenses with the need for a proprietary communications system which can be cost prohibitive. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized the internet instead of a proprietary extranet or intranet in order to reduce communication costs and allow laboratories to be situated at greater distances.

As to claim 4, Jahn is silent as to the use of a secure website or a secure web page accessible via the Internet.

Corrigan discloses that the data should be secure, by being encrypted, in order to protect confidentiality of proprietary information (column 6, lines 21-22). Furthermore, the use of web sites to convey information across the internet as in Corrigan is considered well known and conventional, and in fact, is considered the most conventional mechanism for conveying information across the internet, as it utilizes a low cost mechanism for transmitting information. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilize secure information and convey the information across

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the internet via web sites in order to provide a secure yet cost effective transmission.

As to claim 13, Jahn does not disclose that the input device is capable of accessing a database of test data and configuration data to facilitate troubleshooting.

Corrigan discloses a remote computer or user input device (associated with manufacturing sites) which accesses a database historical operating parameter information for future use, such as different paint formulations (see column 3, lines 19-36; column 7, line 23 to column 13, line 32 which disclose the search of the closest paint formulation from historical test and operating data, especially in column 12, lines 9-16). Furthermore, this database accesses test data and configuration data which facilitates troubleshooting and improvement of the color choices (see columns cited above). Corrigan discloses that this system improves the color quality and choices and the matching capabilities. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized such a database in order to improve the color matching capabilities, the color quality choices and to harmonize results from different manufacturing sites.

Furthermore, as to claim 13, Jahn discloses error correction, i.e., troubleshooting, of the system (see column 8).

Furthermore, as to claims 16 and 17, Corrigan's historical database which is accessible from the internet includes prior results of color matching and painting tinting operations (see column 5, lines 51-62). Furthermore, it is

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notoriously well known and conventional to perform this access via web pages.

Thus, Corrigan's database is a database of case studies based on operational systems to facilitate remote system configuration based on analogous operation parameters. As mentioned above in the rejection of claims 10 and 13, Corrigan discloses that this system improves the color quality and choices and the matching capabilities. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized such a database with case studies accessible from a web page in order to improve the color matching capabilities, the color quality choices and to harmonize results from different manufacturing sites. Furthermore, the system of Corrigan is capable of storing the claimed case studies and discloses both studies with regard to the product and coating material. In any event, Jahn also discloses storing data with regard to the product and coating material (see Figures 8, 9, 10A and 10B)

Claims 23-24 are rejected on similar grounds as claim 16-17 above.

As to claim 25, the apparatus and system is capable of performing the claimed process.

5. Claims 4, 13, 16, 17 and 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Friel as applied to claim 1 above, and further in view of Corrigan (US Patent 6,522,977).

As to claim 4, the selection of Internet Explorer™ or Netscape Navigator™ in Friel can alternatively be interpreted as not disclosing the use of secure

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websites or web pages, and just using nonsecure websites or web pages via the internet.

Corrigan discloses that communications by computer should be secure, such as by encryption. Corrigan further discloses that one would do this in order to preserve the confidentiality of proprietary information. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have used secure websites or secure web pages in order to preserve the confidentiality of proprietary information.

As to claim 13, Friel does not disclose that the input device is capable of accessing a database of test data and configuration data to facilitate troubleshooting.

As to both claims 10 and 13, Corrigan discloses a remote computer or user input device (associated with manufacturing sites) which accesses a database historical operating parameter information for future use, such as different paint formulations (see column 3, lines 19-36; column 7, line 23 to column 13, line 32 which disclose the search of the closest paint formulation from historical test and operating data, especially in column 12, lines 9-16). Furthermore, this database accesses test data and configuration data which facilitates troubleshooting and improvement of the color choices (see columns cited above). Corrigan discloses that this system improves the color quality and choices and the matching capabilities. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized such a

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database in order to improve the color matching capabilities, the color quality choices and to harmonize results from different manufacturing sites.

Furthermore, as to claims 16 and 17, Corrigan's historical database which is accessible from the internet includes prior results of color matching and painting tinting operations (see column 5, lines 51-62). Furthermore, Friel discloses that it is known to perform this access via web pages. Thus, Corrigan's database is a database of case studies based on operational systems to facilitate remote system configuration based on analogous operation parameters. As mentioned above in the rejection of claims 10 and 13, Corrigan discloses that this system improves the color quality and choices and the matching capabilities. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized such a database with case studies accessible from a web page in order to improve the color matching capabilities, the color quality choices and to harmonize results from different manufacturing sites. Furthermore, the system of Corrigan is capable of storing the claimed case studies and discloses both studies with regard to the product and coating material.

Claims 23-24 are rejected on similar grounds as claim 16-17 above.

As to claim 25, the apparatus and system is capable of performing the claimed process.

Response to Arguments

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6. Applicant's arguments with respect to claims 1-5, 12-17, and 21-26 have been considered but are not persuasive.

7. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a control system or structure performing remote configuration in which the user can select among different pumps and guns to configure a spray system) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).


Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to George R. Koch III whose telephone number is (571) 272-1230 (TDD only). If the applicant cannot make a direct TDD-to-TDD call, the applicant can communicate by calling the Federal Relay Service at 1-866-377-8642 and giving the operator the above TDD number. The examiner can normally be reached on M-Th 10-7.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Fiorilla can be reached on (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



George R. Koch III
Patent Examiner
Art Unit 1734

George R. Koch III
9/1/2005